

REMARKS

Claims 1-27 are pending in this application. Claims 1-27 have been rejected. In view of foregoing amendments and following remarks, the Applicants request allowance of the Application.

Introduction

Applicants thank Examiner for the acceptance of drawings filed September 30, 2003.

Claim Rejection under 35 U.S.C. §112

Claims 2-12, 14, 26 and 27 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. Specifically, the Office Action refers the term "domain" recited in these claims as unclear.

Applicants respectfully submit that the term "domain" recited in claims 2-12, 14, 26 and 27 is clear because it is well understood by a person of ordinary skill in the art of computer science. The term "domain" is understood to mean the set of valid values for a given attribute in database design and management system, (*see* Microsoft Computer Dictionary, 5th Ed., 2002, page 172). Therefore, withdrawal of rejections of claims 2-12, 14, 26 and 27 is respectfully requested.

Claim Rejections under 35 U.S.C. §102(b)

Claims 1-10, 13-18, 20 and 22-27 were rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent Application Publication No. 2002/0072999 A1 to Corrie et al. ("Corrie").

To reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

Claims 1-5 Define Over Corrie

Independent claim 1 as amended without prejudice relates to a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors and provides steps of: responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants, determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid, if so, determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database, if the converted data would causes a limit defined under the one of the plurality of grants to be exceeded, and if not, admitting the requested transaction, unless the limit would be exceeded otherwise, rejecting the requested transaction.

The Office Action refers to paragraphs 0056 and 0060 of Corrie as assertedly disclosing the feature of "responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for a grant," refers to paragraphs 0060 and 0061 of Corrie as assertedly disclosing the feature of "determining if the converted data maps to a classification that has been defined under the grant to be valid," and refers to paragraphs 0155 and 164 of Corrie as assertedly disclosing the feature of "if so, determining if the converted data would cause a limit defined under the grant to be exceeded," (see Office Action, page 3, lines 10-23).

The cited paragraphs 0056 and 0060 merely concerns automating the grant issuing process for a grant sponsor, (see Corrie page 4, paragraph 0056), by using a conventional Enterprise Application Integration ("EAI") tool to facilitate the communication between a grant management system and a financial management system of the grant sponsor, (see *id.*, paragraph 0060). The objective of Corrie is to automate the grant application and issuing process for a grant sponsor. Therefore, the method of Corrie is designed for the grant sponsor. In contrast, the present application concerns a computer-implemented method for managing a plurality of grants for a recipient received from a plurality of grant sponsors. Therefore, the method of claim 1 is designed for a grant recipient to automate the management of multiple grants received by the recipient.

Furthermore, the cited paragraphs 0056 and 0060 simply do not identically disclose or even suggest the feature of responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for a grant because the cited paragraphs simply do not even indicate converting data from a domain of a transaction system to a domain for a grant. Similarly, the cited paragraph 0061 merely concerns the functionalities of an out-of-the-box "no coding" adapters of an EAI tool. The cited paragraph 0061 simply does not identically disclose or even suggest determining if the converted data maps to a classification that has been defined under the grant to be valid because the cited paragraph 0061 simply does not even indicate determining if the converted data maps to a classification.

Still Further, the cited paragraphs 0155 merely concerns a determination "as to whether to award a grant to an applicant", (see Corrie, page 14, paragraph 0155, lines 1-2). The cited paragraphs 0164 merely concerns a step in a financial close out process within the grant issuing process, (see *id.* at page 15, paragraph 0163 and 0164). In sum, the cited paragraphs concerns the process of applying for a grant from an applicant to a grant sponsor and issuing a contract for the grant from the sponsor to the applicant, which does not identically disclose or suggest the feature of "determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database, if the converted data would causes a limit defined under the one of the plurality of grants [from a plurality of sponsors to the recipient] to be exceeded" as recited in claim 1. Indeed, any review of Corrie

does not identically disclose or suggest the features recited in claim 1. Therefore, claim 1 is not anticipated by Corrie.

Accordingly, claim 1 is allowable for the reasons set forth above. Claims 2-5 include all features of claim 1 since they ultimately depend from claim 1 and therefore, are allowable for at least the same reasons as claim 1.

Claims 6-10, 26 and 27 Define Over Corrie

Independent claims 6, 10, 26 and 27 include similar new features as claim 1 and therefore, are allowable for the same reasons as claim 1. Claims 7-9 include all features of claim 6 since they ultimately depend from claim 6 and therefore are allowable for at least the same reasons as claim 6.

Claims 13-18, 20, 22-25 Define Over Corrie

Independent claim 13 as amended without prejudice relates to a computer-implemented method for managing a plurality of grants for a recipient received from a plurality of grant sponsors, comprising: receiving a transaction request and data associated with the transaction request from a transaction management system of a grant recipient; determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database, if the transaction request satisfies the rules imposed by the sponsor, and if so, admitting the transaction request; otherwise, rejecting the transaction request.

The Office Action refers to paragraphs 0077, 0160 and 0161 of Corrie as assertedly disclosing features recited in claim 13. The cited paragraphs merely concern communication between a grant grantor and grantee, (*see e.g., Corrie*, page 15, paragraph 0160, lines 15-17) ("At operation 872, the grantee communicates with the granting agency or grantor through the Internet, telephone, mail, or in person."). In contrast, claim 13 is directed to a computer-implemented method for managing a plurality of grants for a recipient received from a plurality of grant sponsors wherein both the transaction management system and the grants management system are of the recipient for which the communication between the transaction system and the grants management system occurs within the grant recipient's organization. For this purpose, the claim 13 makes it plain that a determination is made based on a set of rules derived from administrative and financial requirements of the plurality of grants from a

plurality of sponsors. Therefore, the cited paragraphs 007, 0160 and 0161 do not identically disclose or suggest the features recited in claim 13.

Accordingly, claim 13 is allowable for the reasons as set forth above. Claims 14-18 include all features of claim 13 since they depends from claim 13 and therefore, are allowable for at least the same reasons as claim 13.

Independent claims 20 and 23 include similar new features as claim 13 and therefore, are allowable for the same reasons as claim 13. Claim 22 and 24-25 include all features of claims 20 and 23, respectively since they depend from claims 22 and 23, respectively and therefore are allowable for at least the same reasons as claims 20 and 23.

Claim Rejections under 35 U.S.C. §103(a)

Claims 11, 19 and 21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie in view of Official Notice. Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Corrie in view of U.S. Patent No. 7,111,010 to Chen et al. ("Chen").

Claims 11, 19 and 21 Define Over Corrie and Official Notice

Applicant respectfully traverses all statements of official notice and allegations of well-known fact and respectfully request published information and/or affidavits under 37 C.F.R. § 1.104(d)(2) to support the statements of official notice and allegations of well-known fact.

Furthermore, claims 11, 19 and 21 include all features of independent claims 10, 13 and 20 since claims 11, 19 and 21 ultimately depend from claims 10, 13 and 20, respectively and therefore, are allowable for at least the same reasons as claims 10, 13 and 20 since the Official Notice does not cure the critical deficiencies of Corrie.

Claim 12 Defines Over Corrie and Chen

Claim 12 includes all features of independent claim 10 since claims 12 ultimately depends from claims 10 and therefore, is allowable for at least the same reasons as claims 10 since the secondary reference does not cure or allegedly cure the critical deficiencies of Corrie.

CONCLUSION

All outstanding rejections have been overcome. It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.

Although not believed necessary, the Office is hereby authorized to charge any fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Office is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

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